

**REMARKS**

Reconsideration of this application, as amended, is respectfully requested.

Initially, the Applicants would like to thank the Examiner for the indication that claim 8 contains allowable subject matter and would be allowed if rewritten in independent form including the limitations of its base claim and any intervening claims. Since claims 6 and 10 are not rejected under 35 U.S.C. §§ 102 and 103, the Applicants also assume that the same contain allowable subject matter.

In the Official Action, the Examiner objects to the disclosure because on page 22, both the grasping portion and the sheath are given the label 30. In response, the specification has been amended to be consistent with the drawings; namely, page 22 has been amended to use label 33 in connection with the sheath. Accordingly, it is respectfully requested that the objection to the disclosure be withdrawn.

In the Official Action, the Examiner rejects claims 6, 7, and 10 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 6, the Examiner argues that the same is indefinite because the L-shaped form is disclosed in the specification as being part of the endoscope insertion portion, while claim 6 recites it as part of the longitudinal grasping element. In response, claim 6 has been amended to recite that an L-shaped crank is formed in an inserting shaft portion.

With regard to claim 7, the same has been canceled, thereby rendering the rejection thereof moot.

With regard to claim 10, the Examiner argues that the same is indefinite because as the center of gravity is variable, it is dependent upon the size and weight of the medical instrument and the attitude of the grasping member. In response, claim 10 has been amended to rewrite the same into independent form and to remove the alleged indefiniteness.

The amendment to claim 10 is fully supported in the original disclosure, particularly in the specification from page 22, line 22 to page 23, line 26, which states; "... so that the center of gravity is shifted to the point G' onto the left, thereby causing an unbalance, Then, the set screw 32 is loosened and the grasping portion 30 is moved toward the right hand in the drawing so that the center of gravity (not shown) described above is brought into the position substantially in the vertical line passing through the center Os. Thereafter, the set screw is tightened to fix the grasping portion 30 to the ring member 31. As can be seen from the above, the medical instrument holding device of the third embodiment has a particular effect that even if a sheath or the like is added to the endoscope or the balance is changed by newly added member on the forward side of the ball joint element, the center of gravity of the structure can be adjusted relative to the center position of the ball joint element depending upon the resulting unbalance. As a result, even if the balance of the peripheral portions of the endoscope is changed according to proceeding of operation, the operability is not degraded with the aid of the adjustment."

As described at page 22-23 of the specification, claim 10 relates to a device for folding a relatively small instrument, such as an endoscope or surgical tool, for use in surgical operations. Even if an endoscope or surgical tool is replaced with another one, the outside shape and weight of the instrument will not significantly change; that is, the center of gravity of the structure comprising the instrument and the grasping member changes little, so that the

balance can be adjusted by moving the grasping member. Therefore, claim 10 has been amended to recite that the center of gravity is adjustable and the Applicants respectfully submit that the same is no longer indefinite.

In the Official Action, the Examiner rejects claims 1-3, 7 and 9 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,825,536 to Yasunaga et al., (hereinafter "Yasunaga") in view of Japanese Patent Application No. 2001-258903 (hereinafter "JP 2001-258903"). Additionally, the Examiner rejects claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Yasunaga and JP 2001-258903 and further in view of U.S. Patent No. 5,857,492 to Salamun (hereinafter "Salamun"). Furthermore, the Examiner rejects claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Yasunaga, JP 2001-258903 and Salamun and further in view of U.S. Patent No. 6,569,084 to Mizuno et al., (hereinafter "Mizuno").

With regard to claims 3 and 7, the same have been canceled, thereby rendering the rejection thereof moot.

With regard to independent claim 1 the same has been amended to clarify that the substantially straight line connecting between the center of gravity G of the structure and the position P of the ball center of the ball joint element extends in a direction different from the longitudinal shaft of the grasping member. Neither Yasunaga nor JP 2001-258903 disclose or suggest such a feature.

The amendment to claim 1 is fully supported in the original disclosure. Thus, no new matter has been introduced into the disclosure by way of the amendment to claim 1.

The Examiner regards the vertical direction in Figure 13A of the present application as the longitudinal direction of the holding element 63 (the grasping member).

The Examiner further argues that the direction of the line connecting the center Ob of the ball joint element and the center of gravity C coincides with the longitudinal direction of the holding portion. However, claim 1 recites the longitudinal direction of the grasping member differing from the direction of the shaft member supporting the grasping member (the direction of the line connecting the center of gravity G and the point P of the ball center of the ball joint element). Thus, the medical instrument holding device of claim 1 differs from the structure of the device disclosed in Yasunaga.

With regard to the rejection of claims 1-3, 7 and 9 under 35 U.S.C. § 103(a), independent claim 1 is not rendered obvious by the cited references because neither the Yasunaga patent nor the JP 2001-258903 patent, whether taken alone or in combination, teach or suggest a medical instrument holding device having the features described above. Accordingly, claim 1 patentably distinguishes over the prior art and is allowable. Claims 2 and 9, being dependent upon claim 1, are thus at least allowable therewith (claims 3 and 7 being canceled). Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-3, 7 and 9 under 35 U.S.C. § 103(a).

With regard to the rejections of claims 4 and 5 under 35 U.S.C. § 103(a), since independent claim 1 patentably distinguishes over the prior art and is allowable, claims 4 and 5 are allowable therewith at least because they depend from an allowable base claim.

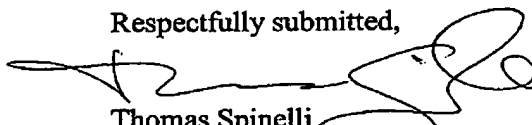
Furthermore, allowable claim 8 has been rewritten in independent form including the limitations of original claim 1. Thus, claim 8 should now be allowed.

Lastly, new claims 11-19 have been added to further define the patentable invention. New claims 11-19 are fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the addition of new claims 11-19.

Applicants submit that independent claims 11 and 12 patentably distinguish over the prior art and are allowable and that claims 13-19 are at least allowable as being dependent from an allowable base claim (12).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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